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124



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/928,599	08/13/2001	Lee Anne Kowalski	SVL920010049US1	7529

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EXAMINER

HUTTON JR, WILLIAM D

ART UNIT	PAPER NUMBER
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2179

DATE MAILED: 08/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/928,599

Applicant(s)

KOWALSKI, LEE ANNE

Examiner

Doug Hutton

Art Unit

2179

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-66 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-66 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

Claims 13, 18, 35, 40, 57 and 62 are objected to because of the following informalities:

- in Claim 13, the term “comprising” in Line 2 should be amended to — consisting of — because the claim appears to be in a “Markush” format; Claims 18, 35, 40, 57 and 62 have the same problem.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 22, 44 and 66 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 22, 44 and 66:

The claims recite the limitation “querying a user *whether to make the matched term distinct*” in Lines 1-2. This limitation is indefinite because it does not correspond

Art Unit: 2179

with Claims 1, 23 and 45, which definitively recite that the matched term is "made distinct."

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-7, 13-22, 45-51 and 57-66 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-7, 13-22, 45-51 and 57-66:

The subject matter specified in the claims is non-statutory and fails to recite patent-eligible subject matter in that it is not technologically embodied on a tangible medium. For example, concerning Claim 45, the "article of manufacture embodying logic for identifying and distinguishing words contained within an electronic message" reads on a piece of paper having written instructions telling the user how to identify and distinguish words contained in a printed "electronic message."

The claimed invention is so abstract and sweeping that it covers the method as practiced by a human operator assisted only by pencil and paper. The claims do not include a particular machine or apparatus, and no machine-implemented steps are recited. Every step is capable of performance by the human mind. A method of this sort, traditionally called a "mental process," is not patentable subject matter.

“Phenomena of nature, though just discovered, “*mental processes*,” abstract intellectual concepts are not patentable as they are the basic tools of scientific and technological work.” (emphasis added) *Gottschalk v. Benson*, 75 U.S.P.Q. 673, 675 (U.S.S.C. 1972). See also, *In re Prater and Wei*, 159 U.S.P.Q. 583 (1968), *rehearing* U.S.P.Q. 571 (1969).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-16, 19-38, 41-60 and 63-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Padwick, Gordon, **Special Edition Using Microsoft Outlook 2002** (Que Publishing, 1 May 2001), in view of Rand et al., U.S. Patent Application Publication No. US 2004/0080528 A1.

Claim 1:

Padwick discloses a method for identifying and distinguishing words contained within an electronic message (see Chapter 17 – Finding and Organizing Outlook Items; “*Using Advanced Find to Find Words and Phrases*” – Padwick discloses this limitation in that Outlook includes an “Advanced Find” tool that allows the user to search emails for a particular term or phrase), comprising the steps of:

- scanning and comparing message terms in an electronic message to significant terms from an online registry to identify any matched significant message terms (see Figure 17.10 – Padwick discloses this limitation in that the “Advanced Find” tool allows the user to enter search terms used in the search in order to identify emails that include the search terms); and
- making distinct the matched significant message term to indicate significance to a reader by displaying the electronic messages that include any matched significant message terms in a table (Padwick discloses this limitation in that Outlook displays the results of the search performed by the “Advanced Find” tool; the results include a table that lists all emails containing the search terms).

Padwick fails to expressly disclose:

- making distinct the matched significant message term to indicate significance to a reader by giving the term a quality that makes it stand out from the other terms in the electronic message.

Rand teaches a method for identifying and distinguishing words contained within an electronic message (see Figures 1 and 3; see Paragraphs 0015 and 0049 – Rand teaches this limitation in that the electronic document display system includes an “Keyword Search” tool that allows the user to search documents for a particular term or phrase), comprising the steps of:

- displaying the electronic messages that include any matched significant message terms in a table (see Figure 3; see Paragraph 0049 – Rand teaches this limitation in that the electronic document display system generates a list of documents that include the search terms); and
- making distinct the matched significant message term to indicate significance to a reader by giving the term a quality that makes it stand out from the other terms in the electronic message (see Paragraph 0049 – Rand teaches this limitation in that the electronic document display system allows the user to click on any of the documents in the list and, upon selection of a listed document by the user, displays the document with the highlighted search term),

for the purpose of indicating the location of the search terms in the document to the user.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, to include the step of making distinct the matched significant message term to indicate significance to a reader by giving the term a quality that makes it stand out from the other terms in the electronic message for the purpose of indicating the location of the search terms in the document to the user, as taught in Rand.

Claim 2:

Padwick discloses the method of Claim 1, wherein the electronic message is an authored electronic message (Padwick discloses this limitation in that the searched

Art Unit: 2179

emails are “electronic messages” that are “authored” by the computer user who wrote them).

Claim 3:

Padwick discloses the method of Claim 1, wherein the electronic message is received electronic message (Padwick discloses this limitation in that the searched emails are “electronic messages” that are “received” by the computer user to whom they were addressed).

Claim 4:

Padwick discloses the method of Claim 1, wherein the significant terms are determined based upon a reader profile (see Chapter 28 – Creating and Using Rules; “*Using the Rules Wizard to Manage Incoming Messages*” and “*Creating Rules for Outgoing Messages*” – Padwick discloses this limitation in that Outlook includes a “Rules Wizard” that allows the user to create rules for processing incoming emails for the “reader”; these rules comprise the “reader profile” that determines the “significant terms”).

Claim 5:

Padwick discloses the method of Claim 1, wherein the significant terms are determined based upon a author profile (Padwick discloses this limitation in that Outlook includes a “Rules Wizard” that allows the user to create rules for processing outgoing

emails for the “author”; these rules comprise the “author profile” that determines the “significant terms”).

Claim 6:

Padwick, in view of Rand, fails to expressly disclose:

- matched significant message terms that are made distinct based upon a reader profile.

However, selecting a particular color or font for display of the located search terms was a design choice that was well-known by one of ordinary skill in the art at the time the invention was made. Rand expressly taught “highlighting” the located search terms, but did not disclose the particular color in which the term is highlighted and whether the color and/or font could be changed by the user. Changing the font and/or color of text in an electronic document was well-known at the time the invention was made by even ordinary computer users. At the time the invention was made, those of ordinary skill in the art – computer programmers – would have known how to design a search tool so a user could select the particular color and/or font in which the located search term was displayed for the purpose of aesthetics.

Additionally, Padwick disclosed a Rules Wizard that allowed the user to compose multiple processing rules that are applied to each received email. Thus, two rules could have been written to locate two different search requests for received emails and display each located term in different colors and/or fonts for the purpose of distinguishing the different search requests within each email. The different located

Art Unit: 2179

terms displayed in different colors and/or fonts would have constituted “matched significant message terms” that are made distinct base upon a “reader profile.”

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, in view of Rand, to include matched significant message terms that are made distinct based upon a reader profile for the purposes of aesthetics and distinguishing the different search requests within each email.

Claim 7:

Padwick, in view of Rand, fails to expressly disclose:

- matched significant message terms that are made distinct based upon an author profile.

However, selecting a particular color or font for display of the located search terms was a design choice that was well-known by one of ordinary skill in the art at the time the invention was made. Rand expressly taught “highlighting” the located search terms, but did not disclose the particular color in which the term is highlighted and whether the color and/or font could be changed by the user. Changing the font and/or color of text in an electronic document was well-known at the time the invention was made by even ordinary computer users. At the time the invention was made, those of ordinary skill in the art – computer programmers – would have known how to design a search tool so a user could select the particular color and/or font in which the located search term was displayed for the purpose of aesthetics.

Additionally, Padwick disclosed a Rules Wizard that allowed the user to compose multiple processing rules that are applied to each sent email. Thus, two rules could have been written to locate two different search requests for sent emails and display each located term in different colors and/or fonts for the purpose of distinguishing the different search requests within each email. The different located terms displayed in different colors and/or fonts would have constituted “matched significant message terms” that are made distinct base upon an “author profile.”

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, in view of Rand, to include matched significant message terms that are made distinct based upon a author profile for the purposes of aesthetics and distinguishing the different search requests within each email.

Claim 8:

Padwick discloses the method of Claim 1, further comprising the step of collecting and storing significant terms in the online registry (see Chapter 28 – Creating and Using Rule; *“Using the Rules Wizard to Manage Incoming Messages”* and *“Creating Rules for Outgoing Messages”* – Padwick discloses this limitation in that Outlook includes a “Rules Wizard” that allows the user to create and save rules for searching incoming or outgoing emails for particular terms; thus, the rules constitute an “online registry” of “significant terms”).

Art Unit: 2179

Claim 9:

Padwick discloses the method of Claim 1, wherein the step of collecting and storing comprises a user selecting significant terms (Padwick discloses this limitation in that Outlook includes a “Rules Wizard” that allows the user to create and save rules for searching incoming or outgoing emails for particular terms; thus, the user “selects significant terms”).

Claim 10:

Padwick discloses the method of Claim 8, wherein the step of collecting and storing comprises importing significant terms (see Chapter 28 – Creating and Using Rule; “*Managing Rules*” – Padwick discloses this limitation in that a set of rules, for searching incoming or outgoing emails for particular terms, can be imported from a file).

Claim 11:

Padwick discloses the method of Claim 10, wherein significant terms are imported from an address book (Padwick discloses this limitation in that a set of rules, for searching incoming or outgoing emails for particular terms, can be imported from a file; a “file” includes an address book).

Claim 12:

Padwick discloses the method of Claim 10, wherein significant terms are imported from a database (Padwick discloses this limitation in that a set of rules, for

Art Unit: 2179

searching incoming or outgoing emails for particular terms, can be imported from a file; a “file” includes a database).

Claim 13:

Padwick discloses the method of Claim 1, wherein the significant terms are selected from the group consisting of names of people, product terms and key words in a user's field (Padwick discloses this limitation in that the Rules Wizard allows the user to select the search terms, which may include “names of people”; for example, see Figure 28.4).

Claims 14-16:

Padwick, in view of Rand, fails to expressly disclose:

- making the matched significant message term a different color, a different font effect, or a different font type.

However, selecting a particular color, font effect, or font type for displaying the located search terms was a design choice that was well-known by one of ordinary skill in the art at the time the invention was made. Rand expressly taught “highlighting” the located search terms, but did not disclose the particular color in which the term is highlighted and whether the color, font effect, and/or font type could be changed by the user. Changing the font effect, font type, and/or color of text in an electronic document was well-known at the time the invention was made by even ordinary computer users. At the time the invention was made, those of ordinary skill in the art – computer programmers

Art Unit: 2179

– would have known how to design a search tool so a user could select the particular color, font effect, and/or font type in which the located search term was displayed for the purpose of aesthetics.

Additionally, Padwick disclosed a Rules Wizard that allowed the user to compose multiple processing rules that are applied to each sent email. Thus, two rules could have been written to locate two different search requests for sent emails and display each located term in different colors, font effects, and/or font types for the purpose of distinguishing the different search requests within each email.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, in view of Rand, to include making the matched significant message term a different color, a different font effect, or a different font type for the purposes of aesthetics and distinguishing the different search requests within each email.

Claim 19:

Padwick discloses the method of Claim 1, wherein making the matched significant message term distinct is performed according to a user setting (Padwick discloses this limitation in that the Rules Wizard allows the user to select the search terms; thus, making the search term “distinct” is performed “according to a user setting”).

Claim 20:

Padwick discloses the method of Claim 19, wherein the significant terms are categorized and the user setting is based upon a category of the significant term (Padwick discloses this limitation in that the Rules Wizard allows the user to select the search terms and process email messages containing each different search term in a particular way; for example, Outlook can search for all emails that include the term “deadline” and send those emails to a certain folder, or Outlook can search for all emails that include the term “office party” and delete those emails; thus, the significant terms are “categorized” and the user setting processes emails having the significant terms “based on a category of the significant term”).

Claim 21:

Padwick fails to expressly disclose displaying the electronic message if the end of the electronic messages as been reached.

Rand teaches a method for identifying and distinguishing words contained within an electronic message (see Figures 1 and 3; see Paragraphs 0015 and 0049 – Rand teaches this limitation in that the electronic document display system includes an “Keyword Search” tool that allows the user to search documents for a particular term or phrase), comprising the step of:

- displaying the electronic message if the end of the electronic messages as been reached (see Paragraph 0049 – Rand teaches this limitation in that the electronic document display system allows the user to click on any of the documents in the

list and, upon selection of a listed document by the user, displays the document with the highlighted search term; thus, the electronic document processing system has scanned the document for the significant term and displays the document “if the end of the electronic messages as been reached”), for the purpose of indicating the location of the search terms in the document to the user.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, to include the step of displaying the electronic message if the end of the electronic messages as been reached for the purpose of indicating the location of the search terms in the document to the user, as taught in Rand.

Claim 22:

Padwick fails to expressly disclose querying a user whether to make the matched term distinct.

Rand teaches a method for identifying and distinguishing words contained within an electronic message (see Figures 1 and 3; see Paragraphs 0015 and 0049 – Rand teaches this limitation in that the electronic document display system includes an “Keyword Search” tool that allows the user to search documents for a particular term or phrase), comprising the step of:

- querying a user whether to make the matched term distinct (see Figures 1 and 3; see Paragraphs 0015 and 0049 – Rand teaches this limitation in that the

electronic document display system allows the user to search the document for particular terms and distinctly displays those terms; thus, the electronic document processing system “queries the user whether to make the matched term distinct”),

for the purpose of indicating the location of the search terms in the document to the user.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, to include the step of querying a user whether to make the matched term distinct for the purpose of indicating the location of the search terms in the document to the user, as taught in Rand.

Claims 23-38 and 41-44:

These claims merely recite an apparatus for performing the method of Claims 1-16 and 19-22. Also, Padwick discloses an “electronic message processor” (Claim 23, Line 3) and Rand teaches an “electronic message editor” (Claim 23, Line 6). Thus, Claims 23-38 and 41-44 are rejected using the same rationale used in the above rejections for Claims 1-16 and 19-22, respectively.

Art Unit: 2179

Claims 45-60 and 63-66:

These claims merely recite computer software for performing the method of Claims 1-16 and 19-22. Thus, Claims 45-60 and 63-66 are rejected using the same rationale used in the above rejections for Claims 1-16 and 19-22, respectively.

Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Padwick, in view of Rand, and further in view of Abu-Hakima et al., U.S. Patent Application Publication No. US 2003/0020749 A1.

Claim 17:

As indicated in the above discussion, Padwick, in view of Rand, discloses/teaches every limitation of Claim 1.

Padwick, in view of Rand, fails to expressly disclose:

- inserting an object near the matched significant message term.

Abu-Hakima teaches a method for identifying and distinguishing words contained within an electronic message (see Paragraphs 0001 and 0006-0008 – Abu-Hakima teaches this limitation in that the electronic document processor searches for concepts and displays those concepts), comprising the steps of:

- inserting an object near the matched significant message term (see Figure 4; see Paragraph 0067 – Abu-Hakima teaches this limitation in that the electronic document processor displays the concept within an icon),

for the purpose of calling the user's attention to the message in which the matched significant message term is located.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, in view of Rand, to include inserting an object near the matched significant message term for the purpose of calling the user's attention to the message in which the matched significant message term is located, as taught by Abu-Hakima.

Claim 18:

Padwick, in view of Rand, fails to expressly disclose:

- selecting an object from the group consisting of an image, a sound file, an icon, a link and a video.

Abu-Hakima teaches a method for identifying and distinguishing words contained within an electronic message (see Paragraphs 0001 and 0006-0008 – Abu-Hakima teaches this limitation in that the electronic document processor searches for concepts and displays those concepts), comprising the steps of:

- selecting an object from the group consisting of an image, a sound file, an icon, a link and a video (see Figure 4; see Paragraph 0067 – Abu-Hakima teaches this limitation in that the electronic document processor displays the concept within an icon),

for the purpose of calling the user's attention to the message in which the matched significant message term is located.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, in view of Rand, to include selecting an object from the group consisting of an image, a sound file, an icon, a link and a video for the purpose of calling the user's attention to the message in which the matched significant message term is located, as taught by Abu-Hakima.

Claims 39 and 40:

These claims merely recite an apparatus for performing the method of Claims 17 and 18. Also, Padwick discloses an "electronic message processor" (Claim 23, Line 3) and Rand teaches an "electronic message editor" (Claim 23, Line 6). Thus, Claims 39 and 40 are rejected using the same rationale used in the above rejections for Claims 17 and 18, respectively.

Claims 61 and 62:

These claims merely recite computer software for performing the method of Claims 17 and 18. Thus, Claims 61 and 62 are rejected using the same rationale used in the above rejections for Claims 17 and 18, respectively.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Helfman et al., U.S. Patent No. 6,396,513; Clark et al., U.S.

Art Unit: 2179

Patent No. 6,725,228; Johnson et al., U.S. Patent No. 5,694,616; and Thurlow et al.,
U.S. Patent No. 6,057,841.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Doug Hutton whose telephone number is (703) 305-1701. The examiner can normally be reached on Monday-Friday from 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached at (703) 308-5186. The fax phone number for the organization where this application or proceeding is assigned is (703) 746-7239.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

WDH
August 14, 2004

A handwritten signature in black ink, appearing to read 'D. Hutton', with a stylized flourish at the end.

**DOUG HUTTON
PATENT EXAMINER
TECH CENTER 2100**